

REMARKS

Claims 1-20 are pending in this application.

Claims 3, 10, 17 and 20 are objected to because of informalities.

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting.

Claims 1-20 are rejected under 35 USC 103(a).

Claims 1, 3, 10, 17 and 20 have been amended.

Objections to Claims 3, 10, 17, and 20

The Examiner objects to claims 3, 10, 17 and 20 because the extraneous word "against" appeared before the word "with". Applicants have made appropriate corrections and respectfully request the Examiner to withdraw the rejection.

Nonstatutory Double Patenting Rejection of Claim 1-20

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending US Patent Application Publication No. 2005/01777447.

Preliminarily, the rejection is being interpreted as a provisional rejection (MPEP § 804 (I)(B) at 800-17 (Rev. 5 Aug. 2006) (Chapter 800 unchanged in Rev. 6), as the copending case has not issued and had not been allowed, as of the time when the rejection was made. We note, for the Examiner's reference, that the copending case has recently been allowed, and ask that the Examiner consider whether the amendments made in that case would put this case in condition for allowance.

Importantly, the Examiner has not provided an analysis that would support an obviousness-type double patenting rejection. The Examiner's statement of his conclusion (OA at 3) does not establish a *prima facie* case of obviousness-type double patenting, because it does not follow the procedure required by law to analyze the issue. This is an arcane area of law, so we looked for a good explanation and demonstration of how to perform the required analysis. One illustrative case is attached.

It is unfortunate that the doctrine is called "obviousness-type" double patenting, because the name tends to mislead examiners into following their typical section 103 type analysis. A crucial difference is that the analysis compares one previously issued

claim to one pending claim. MPEP § 804 (II)(B)(1) at 800-21; 804 (III) at 800-29. Neither references nor claims are combined for comparison to the pending claim: the analysis is one issued claim to one pending claim. Art references have limited use, not to be combined with the reference, but to show what is an obvious variation on or qualitative equivalent to the issued claim. This obvious variation analysis is more like determining inherency for anticipation or to section 112(6) analysis of structural equivalents than it is like section 103 obviousness. The obviousness-type double patenting rejection is a much narrower ground for rejection than section 103 obviousness.

We attach the illustrative case of *Engineered Prods. v. Donaldson Co.*, 225 F.Supp.2d 1069 (N.D. Iowa 2002) *aff'd in part, rev'd in part, vacated in part and remanded*, 147 Fed.Appx 979 (Fed. Cir. Aug. 31, 2005). This case is not controlling precedent, as the Federal Circuit rejected the double patenting defense on different grounds than the District Court and did not authorize publication of its opinion. Nonetheless, the District Court's published opinion is instructive because the judge discussed thoughtfully most of the cases cited in the MPEP plus a few others and followed conscientiously the specified analysis for obviousness-type double patenting. He addressed several issues about which the MPEP is silent.

Where the MPEP § 804 requires the Examiner to "make clear ... [t]he differences between the inventions defined by the conflicting claims – a claim in the patent compared to a patent in the claimed invention", the judge in *Engineered Prods.* did this with a side-by-side comparison. *Id.*, 225 F.Supp.2d at 1094-1100.

The judge in *Engineered Prods.* rejected using prior art references (or other patents) in combination with the base claim. *Id.*, at 1120-23. He explained the role of multiple references for obviousness-type double patenting analysis in these words:

the court's consideration of the import of the "prior art" in *In re Longi* "start[ed] by examining the claims of the [earlier] patent, and by assessing the prior art references in order to ascertain whether the PTO made out a prima facie case of obviousness" of the application claims *in light of the earlier patent and the prior art*. *Id.* at 895-96. *Consequently, the "prior art" was considered in the context of obviousness-type double patenting to determine whether it was a sort of bridge or connection between the claims of the earlier patent and the claims of the application, for one of ordinary skill in the art, to see if it demonstrated that the later application was only an*

"obvious variation" of the claims of the earlier patent. See Eli Lilly, 251 F.3d at 969 (obviousness-type double patenting determines whether "[any] difference renders the claims patentably distinct"); In re Goodman, 11 F.3d at 1052 (because the claimed inventions were not identical in scope, the court was required to determine, at the second step of the analysis, whether the differences defined only an "obvious variation" or a "patentable distinction"). To put it another way, the prior art was used to determine whether the earlier and later patents "obviously" claimed the same thing. In the context of obviousness-type double patenting, the "prior art" was not considered as rendering the application claims "obvious" without regard to the earlier patent that purportedly established obviousness-type double patenting. In re Longi, 759 F.2d at 895-96 (emphasizing, instead, that "a double patenting rejection presupposes a[n] [earlier] patent"). Moreover, it appears that, in In re Longi, what the prior art "taught" was drawn primarily from what was claimed in the prior art patents, not just the structures present in embodiments of the invention. Id. at 896.

Id., at 1122 (*italics and bold facing* in opinion). The judge found the defendant's analysis lacking for any attempt to demonstrate how the prior art would provide a bridge from the claims of the earlier patent to the later claims, by demonstrating, for a person of ordinary skill in the art, that the later claims are only an "obvious variation" of, or "obviously" claiming essentially the same thing, as the earlier patent. *Id.* at 1123.

The judge struggled with a "composite invention" approach to the claims of the issued patent and pending application. *Id.* at 1113-14. At length, he held that any "patently distinct dependent claim would save from invalidation not only itself, but also the independent claim from which the patently distinct dependent claim depends, even if the independent claim ... is not patentably distinct by itself." *Id.* at 1115.

It is clear that the motivation to combine test has no application to obviousness-type double patenting analysis (*id.* at 1121-23), because an obviousness-type double patenting rejection cannot be based on combining claims from two different patents.

With the correct legal standard in mind, which is extremely difficult to find in the MPEP, which requires reading some court cases to find, it becomes clear that the Examiner erred and did not take the steps needed to establish a *prima facie* case. First, the Examiner did not address the dependent claims. Following the judge's reasoning in *Engineered Prods.*, non-anticipation of the dependent claims saves the independent claim. Second, the Examiner has not identified the differences between the claim and asserted that the differences are so minor that they would be obvious

based just on the claims of one reference, without considering the text of the copending application or considering any secondary reference. This is a different approach than the Examiner took in applying section 103 based on the combination of two references.

Applicants respectfully request that the nonstatutory double patenting rejection of claims 1-20 be withdrawn.

Rejection Under 35 U.S.C. § 103(a) of Claims 1-20

The Examiner rejects **claims 1-20** under 35 U.S.C. § 103(a) as unpatentable over Manucha et al. (US 2003/0115072) in view of Melchior et al. (US 2002/0107785).

Claim 1

Claim 1 includes the limitations:

setting authorizations for international shipment participants to view and edit aspects of data that

records the insurance conditions covering the international shipment,

tracks progress of the international shipment participants towards meeting the insurance conditions, and

conditions release of the international shipment on fulfillment, modification or waiver of the insurance conditions;

receiving agreed insurance conditions;

receiving documentation corresponding to fulfillment of the agreed insurance conditions; and

approving release and electronically updating release status of the international shipment, following the evaluation by the exporter or exporter's agent that the agreed insurance conditions have been fulfilled, modified or waived.

These limitations are not found in Manucha et al. in view of Melchior et al.

The Examiner acknowledges that Manucha does not read on insurance conditions, which are part of every element of the claim.

Neither does Melchior discuss requirements for insurance as contract conditions. The point of Melchior is to give insurance companies a new vehicle for selling policies, including selling policies to both parties to a transaction. Melchior [0147]-[0150]. The passages cited by the Examiner do not treat insurance as a contract condition to be

electronically record tracked and evaluated; nor do we find any such discussion elsewhere in Melchior.

Since neither Manucha nor Melchior read on the limitations of this claim, it defies common sense for the combination of references to introduce a feature that neither reference includes. Only by use of hindsight, which is prohibited, would the Examiner go beyond the teachings of either reference and introduce a feature that is only found in these claims and not in either reference. It takes more than combining the reference, it takes exercise of hindsight to modify the combination of the references, before the combination would read on this claim.

Therefore, claim 1 should be allowable over Manucha et al. in view of Melchior et al.

Claim 4

Claim 4 includes the limitations:

further including exposing to view by the international shipment participants status tracking information regarding

establishment of the conditions and instructions for insurance coverage,

the documentation of fulfillment and

the approval of fulfillment, abatement or waiver of the insurance conditions.

These limitations are not found in Manucha et al. in view of Melchior et al.

Neither of the references establishes conditions or instructions for insurance coverage or electronically evaluates fulfillment, abatement or waiver of the insurance conditions. Therefore, neither the references nor their combination can read on exposing this information to view by the international shipment participants. The cited passages of Manucha, [0015]-[0116] make no mention of insurance. Nor does Melchior treat conditions for insurance coverage as contract conditions to be tracked and electronically evaluated.

Therefore, claim 4 should be allowable over Manucha et al. in view of Melchior et al.

Claim 5

Claim 5 includes the limitations:

wherein the exposed status information identifies, for particular roles, whether the particular roles are responsible to carry out a next step in the

establishment of the insurance conditions, the documentation of fulfillment or the approval of fulfillment, abatement or waiver of the insurance conditions.

These limitations are not found in Manucha et al. in view of Melchior et al.

Role-oriented identification of persons responsible to carry out a next step in insurance condition establishment, fulfillment and approval of fulfillment is not found in the cited passages, [0015]-[0016] of Manucha. Paragraph [0015] merely refers to a database, without teaching any useful or interesting application of the database. Similarly, paragraph [0016] merely refers to editing a database, without teaching any useful or interesting application of the database.

Therefore, claim 5 should be allowable over Manucha et al. in view of Melchior et al.

Claim 2

Claim 2 includes the limitations:

wherein the setting authorizations further includes authorizations to view images of documents.

These limitations are not found in Manucha et al. in view of Melchior et al.

The summary of the Mallon PCT publication in Melchior [0008] is too brief to be meaningful. The Examiner's proper course would be to cite the Mallon reference instead of a two sentence summary, which distinguishes Melchior from the claimed teachings and strongly suggests that Mallon lacks meaningful integration.

Therefore, claim 2 should be allowable over Manucha et al. in view of Melchior et al.

Claims 3 and 6

Claims 3 and 6 should be allowable over Manucha et al. in view of Melchior et al. as claim 1, from which it depends.

Claim 7

Claim 7 includes the limitations:

tracking the passage of time between steps, comparing the time passed to predetermined values, and alerting a role when excessive delay is detected.

These limitations are not found in Manucha et al. in view of Melchior et al.

Paragraph [0074] of Manucha, on which the Examiner relies (OA at 7), has nothing to do with this claim. Detecting excessive delay is not discussed by Manucha, either in [0074] or elsewhere.

Therefore, claim 7 should be allowable over Manucha et al. in view of Melchior et al.

Claims 8-14

Claims 8-14 are written from the perspective of the importer using the system, rather than from the perspective of the system itself. The Examiner does not perceive the different perspective, or does not mention it in the rejection (OA at 7).

To the extent that the Examiner relies on the same reference and reasoning as for rejection of claims 1-7, we incorporate by reference and reiterate our response to those grounds of rejection.

In addition, we note that the Examiner has not looked at the references from the perspective of an importer using the system. The interaction between the importer and a computerized system is not described anywhere in the Examiner's basis for rejection.

Therefore, claims 8-14 should be allowable over Manucha et al. in view of Melchior et al.

Claims 15-17

Claims 15-17 are written from the perspective of the beneficiary of insurance coverage procured by the other party. The Examiner does not perceive the different perspective, or does not mention it in the rejection (OA at 7).

To the extent that the Examiner relies on the same reference and reasoning as for rejection of claims 1-7, we incorporate by reference and reiterate our response to those grounds of rejection.

In addition, we note that the Examiner has not looked at the references from the perspective of a beneficiary. The interaction between the beneficiary and a computerized system is not described anywhere in the Examiner's basis for rejection.

Therefore, claims 15-17 should be allowable over Manucha et al. in view of Melchior et al.

Claims 18-20

Claims 18-20 should be allowable over Manucha et al. in view of Melchior et al. for at least the same reasons as claims 1-7.

Applicants respectfully submit that claims 1-20 should be allowable over Manucha et al. in view of Melchior et al.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge underpayment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 50-0869 (TRDB 1007-1).

Respectfully submitted,

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